



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/729,218 | 12/05/2000 | Hirokazu So | 2000 1670A | 3733 |

7590 07/14/2004

WENDEROTH, LIND & PONACK, L.L.P.
Suite 800
2033 K Street, N.W.
Washington, DC 20006

EXAMINER

SHERR, CRISTINA O

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,218

Applicant(s)

SO, HIROKAZU

Examiner

Cristina O Sherr

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the amendment filed 12 April 2004. Claims 1-24 are pending in this case.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 April 2004 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al (US 6,226,618B1) in view of Sako et al (US 6,738,752B2).

Art Unit: 3621

6. Regarding claim 1 and 15 –

Downs discloses a recording medium and method for storing digital data to be read/updated by a data recording and reproducing device, said digital data stored on said recording medium comprising: a plurality of content data reproducible by the data recording and reproducing device; and reproduction control information used to determine said plurality of content data to be reproduced (e.g. col 3 ln 40-55).

Sako discloses the medium of claim 1 wherein said reproduction control information includes reproduction sequence information which determines a reproduction order of said plurality of content data while the data recording and reproducing device performs normal reproduction, and reproduction frequency parameters each of which determines a reproduction frequency of said plurality of content data while the data recording and reproducing device performs special reproduction; wherein said reproduction frequency parameters include a reproduction frequency direct factor, which is directly used as a reproduction frequency at special reproduction, and a reproduction frequency indirect factor which is used to indirectly determine a reproduction frequency at special reproduction; and wherein said reproduction frequency indirect factor is able to be dynamically and automatically updated at a time of reproduction or recording of said content data (e.g. col 3 ln 45 col 3 ln 50).

7. Regarding claims 2-5 and 16 –

Sako discloses a recording medium wherein: said reproduction frequency parameters are updated according to information relevant to said plurality of content data selected at normal reproduction, said attribute- data reproduction frequency indirect factor of said

content data includes information about a date and time of when said plurality of content data was recorded, said reproduction frequency indirect factor of said content data includes information about a date and time of when said plurality of content data was last reproduced, said attribute data reproduction frequency indirect factor of said content data includes information about a number of times said plurality of content data has been reproduced (e.g. col 3 ln 1-35).

8. Regarding claim 6-12 and 17-23 –

Sako discloses a data recording and reproducing device and method for reproducing digital data to be read/updated in the recording medium of claim 1, said device comprising: a determination part operable to read the reproduction control information from the recording medium, and generate information used to determine which of the plurality of content data is to be reproduced based on one of the reproduction sequence information and the reproduction frequency parameters included in the read reproduction control information; a selection part operable to select which of the plurality of content data is to be reproduced based on the information generated by said determination part; and a reproduction part operable to read the plurality of content data selected by said selection part from the recording medium for reproduction; wherein: said determination part is operable to generate, based on the read reproduction control information, reproduction frequency parameters which indicate a reproduction frequency while the plurality of content data is randomly reproduced; and said selection part is operable to randomly select which of the plurality of content data is to be reproduced in such a manner as to satisfy the reproduction frequency indicated by the reproduction

frequency parameters; wherein said selection part comprises: a random number generator operable to generate a random number; and a random number table operable to interrelate the random number with the plurality of content data, and operable to be used to determine which of the plurality of content data is to be reproduced; wherein: at normal reproduction, said determination part is operable to determine a reproduction order of the plurality of content data based on the reproduction sequence information in the read reproduction control information; and said selection part is operable to select the plurality of content data for reproduction in the reproduction order determined by said determination part; information recorded on the recording medium by writing new reproduction control information thereon; wherein said update part is operable to update the reproduction control information recorded on the recording medium based on information relevant to the plurality of content data selected at normal reproduction; and wherein said determination part includes a timer operable to generate time information, and determine a reproduction frequency for each of the plurality of content data by using the time information generated by said timer (e.g. col 1 ln 50 – col 2 ln 5).

9. It would be obvious to one of ordinary skill in the art to combine the teachings of Downs and Sako in order to obtain greater security in control in the distribution of data.

10. Claims 13-14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al (US 6,226,618B1) in view of Sako et al (US 6,7389,752B2).

11. Regarding claims 13 and 24 -

Downs discloses a reproduction control information collection system and method in which an information provider collects reproduction control information, indicative of a

Art Unit: 3621

user's preference of content data, for sale to a content merchandiser, and rewards the user with a bonus for the reproduction control information, said system comprising: a user system provided on a user side; an information provider system provided on an information provider side; and a content merchandiser system provided on a content merchandiser side, wherein: said user system, said information provider system, and said content merchandiser system are interconnected with one another via a network for information exchange (e.g. col 3 ln 45 col 3 ln 50).

Sako discloses a user system, which is operable to transmit the user reproduction control information indicative of the user's preference of content data over the network; said information provider system is operable to receive the user reproduction control information which came from said user system, and transmit, over the network, the user's reproduction control information together with an ID uniquely identifying the user to said content merchandiser system; in response to the reproduction control information and the ID provided by said information provider system, said content merchandiser system is operable to issue a password uniquely corresponding to the ID, and transmit the password to said information provider system over the network; said information provider system is operable to transmit the password and the ID provided by said content merchandiser system to said user system over the network; said user system is operable to present the ID and the password provided by said information provider system to said content merchandiser system over the network, and ask for the bonus; and said content merchandiser system is operable to identify the user

Art Unit: 3621

with the presented ID and password, and provide the bonus to the identified user (e.g. col 1 ln 50 – col 2 ln 5).

12. Regarding claim 14 –

Sako discloses the reproduction control information collection system according to claim 13, wherein: said user system comprises a communications part operable to communicate with said information provider system and said content merchandiser system via the network; and a reproduction control information management part operable to manage the user reproduction control information for transmission to said information provider system via said communications part with a predetermined timing; said information provider system comprises: a communications part operable to communicate with said user system and said content merchandiser system via the network; a user information management part operable to manage information about the user in addition to the ID; and a reproduction control information database operable to interrelate the reproduction control information, the ID, and any corresponding content with one another for storage; and said content merchandiser system comprises: a communications part operable to communicate with said information provider system and said user system via the network; a bonus offer part operable to provide the bonus to said user system via the communications part; and a password management part operable to issue and manage the password, and authenticate a correspondence between the ID and the password presented by said user system (e.g. col 3 ln 1-35).

13. It would be obvious to one of ordinary skill in the art to combine the teachings of downs and Sako in order to obtain greater security in control in the distribution of data.

Art Unit: 3621

14. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

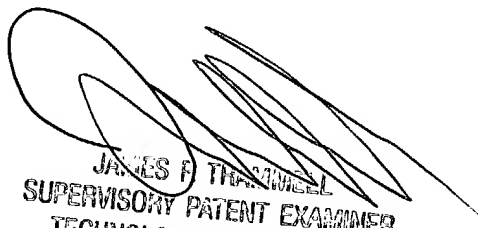
16. Imai et al (US 5,687,157A) discloses a method of recording and reproducing digital audio signal and apparatus thereof.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3621

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JAMES F. THAINWELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600